

**REMARKS**

By the present amendment, Applicant has amended Claims 1, 2, 6, 7 and 8. Claims 12-16 have been added. Claims 1-16 remain pending in the present application. Claims 1, 7 and 12 are independent claims.

In the recent Office Action the Examiner rejected Claim 6 under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicant has deleted from Claim 6, the claim language that the Examiner has found to be indefinite and confusing. Applicant respectfully submits that Claim 6, as amended, meets the specific requirements of 35 U.S.C. § 112, second paragraph.

In the recent Office Action the Examiner rejected Claims 1, 4, 5, 7, 10 and 11 under 35 U.S.C. § 102(b) as being anticipated by Sampsell (US 3,046,616). Claims 2, 3, 6, 8 and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Sampsell (US 3,046,616), taken alone.

Applicant will advance arguments hereinbelow to illustrate the manner in which the presently claimed invention is patentably distinguishable from the cited and applied prior art. Reconsideration of the present application is respectfully requested.

The Examiner rejected Claims 1, 4, 5, 7, 10 and 11 under 35 U.S.C. § 102(b) as being anticipated by Sampsell. The patent to Sampsell (US 3,046,616) discloses a trim



member 23 having a U-shaped cross section with a web 19 and a pair of different sized legs 20 and 21. The trim member 23 is formed of plastic or metal, and is flexible so that the longer leg of the trim member may be inserted into a slot 22 cut into a door jamb 17, with the trim member flexing and the shorter leg bearing against a wall board 15. However, Sampsell does not disclose 1) a substantially rigid trim member having, 2) an L-shaped cross section with, 3) the elongated arm of the L-shaped cross section having a free end, so that the integral arm section and the free end will overlay an existing door molding when the trim section is installed. These limitations are recited in each of Applicant's independent Claims 1, 7 and 12. A prior art reference only anticipates the subject matter of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (see Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984)). Since the patent to Sampsell does not show each and every feature of Applicant's invention, as recited in amended independent Claims 1 and 7, the rejection of these claims under § 102(b) is improper and should be withdrawn.

The Examiner rejected dependent Claims 2, 3, 6, 8 and 9 under 35 U.S.C. § 103(a) as being unpatentable over Sampsell (US 3,046,616). The Examiner believes that it would have been obvious to modify Sampsell by making the trim member of wood or fiberboard, to have the integral arm section defining a setback of about 0.25 inch, and to make the trim section of Sampsell about seven feet in length. Applicant does not agree. In this regard, if the trim member of Sampsell were to be made of wood or fiber board it simply would not



work in the manner intended. The device of Sampsell is made from plastic or a thin metal so that it can flex, and so that the longer leg can be inserted into a slot in the door jamb. Additionally, as noted above, the amended claims require that Applicant's trim be substantially rigid, of L-shaped cross section, with the elongated arm of the L-shape having a free end. These limitations are not shown in Sampsell, nor are they made obvious thereby. There is no teaching or suggestion in Sampsell which would lead one of ordinary skill in this art to make the above-noted modifications, since to make those modifications would prevent the Sampsell trim member from being used in the manner in which it is intended. If a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). See M.P.E.P. § 2143.01.

Obviousness is tested by "what the combined teachings of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). There is nothing in the teachings of the relied upon prior art reference which would have suggested the desirability, and thus the obviousness of the Examiner's modifications of the trim member of Sampsell. It is therefore Applicant's conclusion that the teaching of Sampsell fails to establish a *prima facie* case of obviousness.



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Independent Claim 12 and dependent Claims 13-16 have been added to the present application and include all the limitations of independent Claim 1. Thus, for the same reasons stated above, Claims 12-16 are considered to be allowable over the cited prior art.

The remaining references cited in the present application, but not applied by the Examiner in the rejection of the claims have also been carefully reviewed, however, Applicant finds nothing therein which would overcome or supply that which is lacking in the basic reference to Sampsell noted above.

The claims in this application have been revised to more particularly define Applicant's unique construction in view of the prior art of record. Reconsideration of the claims in light of the amendments and for the above-noted reasons is respectfully requested.

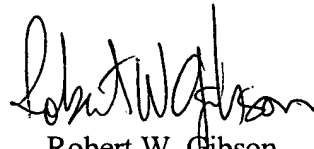


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For the foregoing reasons, Applicant respectfully submits that the present application is in condition for allowance. If such is not the case, the Examiner is requested to kindly contact the undersigned in an effort to satisfactorily conclude the prosecution of this application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Robert W. Gibson", is written over the typed name.

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